

REMARKS

Claims 1-15 are pending. By this Amendment, the title is amended. Reconsideration in view of the above amendment and following remarks is respectfully requested.

The title was objected to. The title has been amended to obviate the objection. Reconsideration and withdrawal of the objection are respectfully requested.

Claims 1-15 were rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-37 of U.S. Patent 6,649,893. Although Applicants respectfully resubmit that the rejection fails to present a *prima facie* case of obviousness-type double patenting (i.e. the Examiner acknowledges that certain features of claims 1-15 are not included in claims 1-37 of U.S. Patent 6,649,893 and merely presents conclusions that, as opposed to reasons why, the missing features would have been obvious), in order to advance prosecution of the instant application, a Terminal Disclaimer obviating the rejection is included with the instant response.

Claims 1, 2, 11, 12 and 14 were rejected under 35 U.S.C. § 102(e) over Tanaami (U.S. Patent Application 2004/0182710 A1) and claims 3-10, 13 and 15 were rejected 35 U.S.C. 103(a) over Tanaami. The rejections are respectfully traversed.

Tanaami discloses a microscopic spectrometer for obtaining spectrometric information of fluorescence emitted from a sample. The reader and system of Tanaami is designed to obtain spectrum of multi-color fluorescence by irradiating the sample with exciting light from the light source and introducing the fluorescence emitted from the sample to a grating or a Fourier spectrometer. The user can thus observe an electrophoretic migration/electrocataphoresis pattern.

Tanaami does not disclose or suggest obtaining information on focus detection on the basis of a multi-spot beam. According to Tanaami, the observation light is merely analyzed spectrometrically. Therefore, Tanaami fails to disclose a focus detecting device for a microscope, as recited in claims 1 and 11.

Moreover, the grating G of Tanaami (which the Examiner equates to the claimed multi-beam producing member) is disposed in the observation path (from the sample S to the optical detector 109), not in the path of light from the light source to the photodetector, as recited in claim 1, or between the light source and the sample, as recited in claim 11. Tanaami thus does not anticipate or render obvious claims 1 and 11.

Claims 2-10 and 12-15 recite additional features of the invention and are allowable for the same reasons discussed above with respect to claims 1 and 11 and for the additional features recited therein.

It is also respectfully submitted that the rejection of claims 3-10, 13 and 15 fails to present a *prima facie* case of obviousness. For each claim, the Examiner acknowledges that Tanaami fails to include a specified limitation(s) of the claim, but merely concludes that “selecting a specific or particular” element would have been obvious. MPEP § 2143 states that in order to establish a *prima facie* case of obviousness, a reference must include all the claim limitations. As Tanaami does not include, at least, all of the features of claims 3-10, 13 and 15 acknowledged by the Examiner to be missing, Tanaami can not present a *prima facie* case of obviousness.

Furthermore, MPEP § 2143 requires that there be some teaching, suggestion or motivation, either explicitly or implicitly, in the prior art reference, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. The Examiner has merely stated conclusions that it would have been obvious to modify Tanaami, without presenting any teaching, suggestion, or motivation for doing so.

Reconsideration and withdrawal of the rejections over Tanaami are respectfully requested.

In view of the above amendments and remarks, Applicants respectfully submit that all the claims are allowable and that the entire application is in condition for allowance.

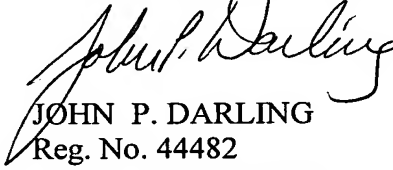
Should the Examiner believe that anything further is desirable to place the application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

FUJIMOTO et al. -- 10/689,541  
Attorney Docket: 061069-0306016

Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,

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Attachment: Terminal Disclaimer (U.S. Patent 6,649,893)